

REMARKS

Applicants affirm the election to prosecute the invention of Group I, claims 1-20, 25-31 and 38-40. Furthermore, the election of the third compound in claim 25 on page 178 as the "core structure" is similarly affirmed. Claims 21-24 and 32-37 have been canceled as being drawn to a non-elected invention. Applicants reserve the right to further prosecute the subject matter of these claims in a continuing application since they are not being abandoned.

In response to the requirement stated by the Examiner on page 4 of the Office Action, the following claims read on the elected structure represented by the third compound in claim 25 as noted above: Claims 1, 3-5, 7-20, 25-29 and 38.

Claims 3, 25, 26, 28 and 30 have been amended pursuant to the Examiner's remarks appearing on page 6 of the Official Action. Specifically, claim 3 has been amended to delete the grammatically incorrect presence of the verb "is." Claims 25, 26 and 30 have been amended to spell out the abbreviation for "HCV", namely, hepatitis C virus. Claim 28 has been amended to replace the phrase "still additionally" with the equivalent term "further." Withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, is respectfully requested in view of these amendments. Finally, claims 1, 2 and 3 have been amended as discussed below. Entry of these amendments is respectfully requested.

Claim 19 has been amended pursuant to the rejection under 35 U.S.C. § 112, second paragraph. The Examiner states that claim 19 provides for the use of a pharmaceutical composition, but the claim does not set forth any steps involved in a method or process. This rejection is traversed.

Claim 19 has been amended to include the term "suitable" in order to create the phrase "suitable for." Consequently, the amendment introduces a limitation that requires the claimed compositions to "so perform" or not meet the terms of the claim. As a result, the phrase constitutes a patentable limitation. In this regard, the Examiner's attention is invited to the decision in *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 9890, 54 U.S.P.Q.2d 1227 (Fed. Cir. 2000), *cert. denied*, 531 U.S. 1183 (2001). In that case, the patent's 41 claims to gasoline compositions that reduced automobile tail pipe emissions were held not anticipated by prior art specialty fuel compositions, such as racing and aviation fuels. All of the claims began with either the phrase "[a]n unleaded gasoline *suitable for* combustion in an automotive engine" (emphasis added) or the phrase "[a]n unleaded gasoline fuel *suitable for* combustion in a spark ignition automotive engine" (emphasis added). The Federal Circuit held that the district court correctly interpreted the claims as limited to "mass market automotive gasoline." In other words, consistent with Applicants' presentation of the claim, as amended, the phrase "suitable for" was interpreted as having patentable significance in conjunction with the other terms of the claim. Respectfully, the same circumstances apply herein. Additionally, in *In re Watson*, 517 F.2d 465(1), 476(2)-477, 186 U.S.P.Q. 11(3), 20 (C.C.P.A. 1975), the court concluded that the claim phrase "an effective amount of a germicide *suitable for* use in oral hygiene" is not indefinite. *Id.* (emphasis added). Although the court directed its attention to the amount of a germicide, there was no objection to the use of the phrase "suitable for" in the claim. Withdrawal of this rejection is respectfully requested.

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO 98/13462, *McIver et al.* (hereinafter "McIver"). The Examiner relies on the disclosures at page 3, lines 9-22, and page 5, lines 14-37, to construct the structure shown in the Official Action at page 7. The Examiner then recites several of the generic structures in claim 1 and claim 2 of the present application and selects various components for these generic components in order to arrive at the illustrated structure noted above. This rejection is traversed.

It is respectfully noted that the structure illustrated on page 7 of the Office Action cannot be obtained based on the generic structures on page 5 of *McIver*; the reference discloses C-terminal aldehydes, whereas the compound illustrated in the Office Action is a C-terminal alcohol. Instant claim 1 encompasses C-terminal aldehydes, acids, ketones, esters, amides dicarbonyl derivatives, and amino acid residues.

The disclosures of *McIver* referred to in the Office Action are generic disclosures, not disclosures of specific compounds allegedly within the scope of instant Claims 1 and/or 2. The Examiner is picking and choosing among the teachings of the reference to arrive at the compounds of instant claims 1 and 2. However, such picking and choosing is not appropriate in a 35 U.S.C. § 102 analysis. See, e.g.:

"Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the 'prior art'". . . . the [r]eference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings in the cited references. Such picking and choosing may be entirely proper when making a rejection of a 103, obviousness

rejection, where the applicant must be afforded opportunity to rebut with objective evidence any inference of obviousness which may arise from the *similarity* of the subject matter which he claims to the prior but it has no place in the making of a 102, anticipation rejection." (emphasis original). *In re Arkey, Eardly, and Long*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

Overlap of the genus taught in the reference and the genus of instant claims 1 and 2 is not sufficient to establish anticipation. Furthermore, *McIver* is directed to subject matter that differs significantly from that of the present invention; specifically, liquid detergent compositions (reference) versus drugs for treatment of HCV (present invention). Consequently, there is no motivation in *McIver* to make the selections suggested by the Examiner to arrive at the allegedly overlapping compounds, absent Applicants' own teachings. It is respectfully suggested that the rejection is incorrect and should be withdrawn.

However, the compounds of Synthesis Example 3(b), (c) and (e) of the reference do appear to be within the scope of instant claims 1 and/or 2. Consequently, claim 1 has been amended to exclude these compounds from the scope of the instant claims by amending the recitation in the definition of generic component R⁵ to delete "H" and OR⁸ (where R⁸ is alkyl). Withdrawal of this rejection and allowance of these claims is respectfully requested in view of the amendment and remarks.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at

(908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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